

REMARKS

Claims 1, 4-17, 19-23, 25-38 and 44-47 are pending in the application.

Claims 1, 4-17, 19-23, 25-38 and 44-47 have been rejected.

No Claims have been amended, and reconsideration of the Claims is respectfully requested in light of the following arguments, legal principles, and remarks.

I. **REJECTIONS UNDER 35 U.S.C. § 103**

Claims 1, 2, 4, 6-9, 11-15, 17-38 and 44 [and Claim 45] were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carter (US Patent No. 6,266,782) in view of Nizamuddin (US Patent No. 5,136,585).¹ Claims 5, 10, 16, 46 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carter (US Patent No. 6,266,782) in view of Nizamuddin (US Patent No. 5,136,585) and further in view of Marchetti (US Patent No. 6,618,398). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant

¹ As noted by Applicant in its prior response, Claim 2 was previously canceled and is no longer pending.

of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142. In making a rejection, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir 2006) (cited with approval in *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

Initially, with respect to all of the rejections based on the main reference Carter, Applicant respectfully disagrees with the Office Action's assertion that Carter discloses the invention substantially as claimed. In fact, Carter discloses substantially less than that claimed.

First, the Office Action contends that Figure 4 and column 7, lines 16-62, of Carter disclose maintaining a logical model of the aggregate logical device. Figure 4 of Carter illustrates the context in which its protocol error correction method operates. See column 7, lines 16-18. The figure provides a model that Carter asserts is useful to explain some of the problems to be solved by its protocol error correction method. See column 7, lines 18-21. The figure is a logical model of two

H.323-capable telephony devices connected via channels over a computer network. See column 7, lines 39-42. The channels are a two-way H.323 audio channel 94, a T.120 application-sharing channel 96, and a protocol error correction channel 98. See column 7, lines 49-57.

The Applicant respectfully submits that Figure 4 and its description are employed to illustrate an embodiment of the Carter protocol error correction method – not to illustrate maintaining a logical model of an aggregate logical device (having a plurality of device components logically associated together). Furthermore, the Applicant is unable to find description in Carter of steps taken to maintain the logical model presented in Figure 4. Moreover, there does not seem to be any description similar to Applicant’s claim language of wherein a state of each device component within said aggregate logical device is maintained.

Second, the Office Action states that Carter teaches providing access to a data network service by representing a selection of a device component to the service as an aggregate logical device, citing Figure 2, column 4, lines 57-64, and column 5, lines 20-45. The cited passages do not appear to disclose or mention that both of the two H.323 client devices engaged in a connection (as shown in Figure 4) are represented to a data network service (or stand-alone service) as an “aggregate logical device.”

For at least these reasons, there appears to be no disclosure or description in the Carter reference that (1) the two H.323 devices/nodes of Figure 4 are logically associated in an aggregate logical device, (2) a logical model is maintained of the aggregate logical device and a state of each device component is maintained within the aggregate logical device, or (3) the plurality of device components is represented to a data network service as the aggregate logical device. Sec, independent Claims 1, 37, 38, 44 and 45. Thus, Carter does not disclose, teach or even suggest these elements/features of Applicant’s claims as identified by the Office Action (and the Office Action fails to identify any pertinent disclosure in Nizamuddin that would cure these deficiencies in Carter).

In addition, and importantly, Applicant’s independent claims recite communicating (or communicate, or a message driver for communicating) with a plurality of stimulus device components using stimulus messaging in accordance with an elemental control protocol (in one

claim - specifically reciting SIP as the elemental control protocol). Carter fails to disclose these features/elements, and the Office Action concedes this issue and agrees that Carter fails to disclose “a stimulus device and stimulus messaging in accordance with an elemental control protocol.” Office Action, page 3.

However, the Office Action asserts that, “in the same field of endeavor,” Nizamuddin discloses “a stimulus device and stimulus messaging in accordance with an element control protocol.” Office Action, page 3 (citing paragraphs 0072, 0084 and 0111). Applicant respectfully disagrees that Nizamuddin is within the same field of endeavor as Carter. Carter is directed to inband protocol correction in computer networking software in distributed object networking. Carter, Abstract. Nizamuddin, on the other hand, is directed to a digital key telephone system and relates to ports and providing communication paths between the ports. Nizamuddin, Abstract. There is simply no teaching or suggestion to combine the elements/features described in Nizamuddin’s digital key telephone system with an apparatus and method for correcting protocol errors in computer networking software in order to render Applicant’s apparatus and methods for providing device control to a plurality of device components. Therefore, Applicant submits that the proposed combination involves teachings from unrelated art.

Even assuming the cited references are related enough to be the subject of combination, there is no teaching or suggestion that the asserted teachings of Nizamuddin should be combined with Carter. No logical reasoning or underpinning exists for combining those elements/features asserted by the Office Action (e.g., a stimulus device and stimulus messaging) as being taught by Nizamuddin with correction of protocol errors in networking software. The Office Action’s reasoning is erroneous in that it asserts the teachings of Nizamuddin should be combined with Carter “to have a stimulus device and stimulus messaging in accordance with an element control protocol, for the purpose of providing a signaling and supervision link between, any of said ports and a processing device in the key telephone system.” Office Action, page 4. This merely describes Nizamuddin’s teachings - with no reference to Carter’s underlying disclosure or why it would benefit Carter. Thus, there is no reasoning, logical or otherwise, as to why Nizamuddin’s elements should be combined

with Carter. The Office Action's conclusion of obviousness is based merely on the erroneous assertion that Carter and Nizamuddin separately disclose all recited claim elements - which alone is insufficient to support an obviousness rejection.

Accordingly, the Applicant respectfully submits that the Claims are not obvious in view of the respective (asserted) teachings in Carter and Nizamuddin, and requests the Examiner withdraw the § 103(a) rejection of Claims 1, 4, 6-9, 11-15, 17-38 and 44-45.

The Marchetti reference

In addition to the above, with respect to the rejection of Claims 5, 10, 16, 46 and 47, Applicant again (see Applicant's prior responses dated November 22, 2004, March 23, 2007, and July 8, 2008) notes that the third reference that forms the basis of the 103(a) rejection of these claims is United States Patent No. 6,618,398 to Marchetti. Section 103(c)(1) provides that:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Title 35, United States Code, § 103(c)(1). See also, MPEP § 2146.

The present application is owned by Nortel Networks Limited, as evidenced by documents recorded at Reel 011348, Frame 0695 (assignment from the inventors to Nortel Networks Limited). The cited reference, US 6,618,398, shows Nortel Networks Limited as the assignee. Therefore, the present application and the cited reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person. As a result, the Marchetti reference is unavailable as prior art under section 103(a) and the Office Action fails to establish a *prima facie* case of obviousness.

Applicant respectfully requests withdrawal of this § 103(a) rejection of Claims 5, 10, 16, 46, and 47.

II. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@munckcarter.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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